



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,524	10/12/2001	Weng Tao	19141-543 Natl.	9720

7590 02/11/2003
Ivor R Elrifi
Mintz Levin Cohn Ferris Glovsky & Popeo
One Financial Center
Boston, MA 02111

EXAMINER

WILSON, MICHAEL C

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,524

Applicant(s)

TAO ET AL.

Examiner

Michael C. Wilson

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Priority

Applicants' request for priority under 35 U.S.C. 371 to PCT/US99/24630, which is a CIP of 09/178,869, has been accepted (paper number 5, April 9, 2002). The priority document, WO 00/24897, has been entered. This application is a 371 of PCT/US99/24630, which is a CIP of 09/178,869, now US Patent 6,197,294.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The description of the drawings is not adequate. The heading for each figure should include subfigures. For example, the description of Fig. 1 on pg 5, line 15, should begin --Figure 1A-1C shows...-- instead of "Figure 1 shows...."

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-8, drawn to cells comprising a vector encoding a fusion protein operably linked to a promoter, wherein the fusion protein encodes i) an

immunostimulatory cell surface protein linked at the amino terminus to "second cell surface polypeptide" comprising a transmembrane region.

Group II, claim 9, drawn to a nucleic acid sequence encoding an immunostimulatory cell surface protein operably linked to a promoter, wherein said immunostimulatory cells surface protein i) activates phagocytes, and ii) does not fix complement.

Group III, claims 10-12, drawn to a protein comprising a cell surface Fc expressed in reverse orientation to the cell surface.

Group IV, claims 13-15, drawn to *in vitro* methods of screening phagocytes using transformed cells expressing an immunostimulatory cell surface molecule in reverse orientation to the cell surface, and *in vitro* methods of identifying agents using such cells.

Group V, claim(s) 16-28, drawn to a method of stimulating phagocyte activity in a host using transformed cells containing a polynucleotide encoding an immunostimulatory cell surface protein operably linked to a promoter, wherein said immunostimulatory cell surface protein i) activates phagocytes, and ii) does not fix complement.

Group VI, claim 29, drawn to a composition comprising i) a core comprising transformed cells having a polynucleotide encoding an immunostimulatory cell surface protein operably linked to a promoter, wherein said immunostimulatory cell surface protein is capable of stimulating an immune response in a host; and ii) a jacket comprising a permselective membrane surrounding the core.

Group VII, claim 30, drawn to a method of delivering a biologically active molecule to a patient using a composition comprising a capsule having i) a core comprising transformed cells having a polynucleotide encoding an immunostimulatory cell surface protein operably linked to a promoter, wherein said immunostimulatory cell surface protein is capable of stimulating an immune response in a host; and ii) a jacket comprising a permselective membrane surrounding the core.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The Groups do not share the same "special technical feature". The cells of Group I require a polynucleotide encoding a fusion protein operably linked to a promoter, wherein the fusion protein encodes i) an immunostimulatory cell surface protein linked at the amino terminus to "second cell surface polypeptide" comprising a transmembrane region. Group II does not require the cell surface protein encoded by the polynucleotide is a fusion protein, or that the cell surface protein encodes i) an immunostimulatory cell surface protein linked at the amino terminus to "second cell surface polypeptide" comprising a transmembrane region as in Group I. Nor do Groups III-VII require a cell surface protein comprising a fusion protein encoding i) an immunostimulatory cell surface protein linked at the amino terminus to "second cell surface polypeptide" comprising a transmembrane region. As such, the Groups do not share the same "special technical feature."

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson whose telephone number is 703-305-0120. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on 703-305-4051. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



MICHAEL WILSON
PRIMARY EXAMINER